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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,494	07/11/2003	James Owen	ORACL-01370US0	5406
80548	7590	02/03/2009	EXAMINER	
Fliesler Meyer LLP 650 California Street 14th Floor San Francisco, CA 94108			KIM, PAUL	
			ART UNIT	PAPER NUMBER
			2169	
			MAIL DATE	DELIVERY MODE
			02/03/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/618,494

**Applicant(s)**

OWEN ET AL.

**Examiner**

PAUL KIM

**Art Unit**

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 5, 18, 20, 22, 23, 34-38, 40, 42, 54-58, 60, 62, 63 and 75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 20, 22, 23, 34-38, 40, 42 and 43 is/are rejected.
- 7) ☒ Claim(s) 1-2, 4-5, 54-58, 60, 62-63, and 75 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/17/08, 1/16/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office action is responsive to the following communication: Amendment filed on 17 December 2008.
2. Claims 1-2, 4-5, 18, 20, 22-23, 34-38, 40, 42, 54-58, 60, 62-63, and 75 are pending and present for examination.

***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 December 2008 has been entered.

***Response to Amendment***

4. Claims 1, 18, 34, and 54 have been amended.
5. Claims 6-7, 24-25, 44-45, and 64-65 have been cancelled.
6. Claim 75 has been newly added.

***Information Disclosure Statement***

7. The information disclosure statements (IDS) submitted on 17 December 2008 and 16 January 2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Specification***

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The Specification fails to provide proper antecedent basis for "a machine readable medium" as recited in claims 54-58, 60, 62-63.

***Claim Objections***

9. **Claims 1, 18, 34, 54, and 75** are objected to because of the following informalities: The present claims recite "a forth group of services that configure VCRs." It is noted that the aforementioned recitation should read as "a fourth group of services that configures VCRs." It is noted that said claims are replete with similar subject/verb informalities. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. **Claims 18, 20, and 22-23** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is noted that the limitations of the claims may be considered to be software, per se, since the claims fail recite a functional interrelationship between the software architecture (i.e. a program product) and hardware components which permit the software's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a program, the computer program itself is not a process and is nonstatutory functional descriptive material. See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. MPEP 2106. "The claimed invention as a whole must accomplish a practical application. That is, it must produce a 'useful, concrete and tangible result'" (emphasis added).

12. **Claims 34-38, 40, and 42-43** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The method claim of the aforementioned claims fails to fall within the statutory categories of 35 U.S.C. 101 because the method claim is neither (1) tied to another statutory class (i.e. particular machine or apparatus) nor does it (2) transform underlying subject matter (such as an article or material) to a different state or thing. Accordingly, the method claim (i.e. a process) may be performed mentally or manually in a manner that reasonably accomplishes the intended purpose of the recited invention, as claimed, without the use of a structure. That is, the method claim fails to positively recite the particular machine or apparatus to which it is tied. While the claims recite that a "a service provider interface (SPI) to be implemented by each of the plurality of content repositories," it is noted that, for the purposes of this examination, a content repository has not been explicitly claimed nor defined as including hardware components. Accordingly, the method step of providing of a service provider interface fails to explicitly statutory subject matter which maybe structurally tied or inherently involved in the step.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL KIM whose telephone number is (571)272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571) 272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2169

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Kim/

Paul Kim  
Examiner, Art Unit 2169